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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,689	03/24/2000	Shigeo Suzuki	1232-4396US1	1838

7590 06/05/2003

Michael M. Murray Esq.
Morgan & Finnegan L L P
345 Park Avenue
New York, NY 10154

EXAMINER	
BAYAT, BRADLEY B	
ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/534,689	Applicant(s) SUZUKI, SHIGEO
	Examiner Bradley Bayat	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *March 13, 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *34-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *34-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *08/978,072* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Status of Claims

Applicant has canceled claims 20-33 and added new claims 34-42 in the amendment filed March 13, 2003. Thus, claims 34-42 are pending and are presented for examination on the merits.

Response to Arguments

Applicant's arguments filed on March 13, 2003 have been fully considered but they are not persuasive.

Applicant asserts that new independent claims 34, 38 and 39 recite a transmitting side that is "capable of charging by a log that is recorded according to a request of information concerning the decoding that is sent from a receiving side (p.5 of applicant's response)." Applicant further asserts, "no such charging feature is taught or suggested by Kubota and Hayashi." In response to applicant's argument, the examiner directs the applicant to the charging feature in the Hayashi patent (see columns 6-8). Hayashi illustrates a charging mechanism that includes a logging timing feature, wherein charging is determined in units of time or programs (column 7, lines 22-26). In addition, a logging mechanism is used wherein the fee corresponding to the actual viewing time is detected by the timer that can subtract fees or charge a user's account (column 8, lines 16-25).

Applicant also asserts that new independent claims 40-42 recite "a requesting step that continuously requests information from a transmission side concerning the decoding of encrypted data, and then stops requesting the information if watching and listening of that information ends (p.5 of applicant's response). Applicant further asserts that this feature is

neither taught nor suggested by Kubota and Hayashi. In response to applicant's arguments, the examiner points out that one of the payment mechanisms taught by Hayashi is where a user wishes to stop receiving the program in the time pay-per-view mode, and the user merely turns off the program. Thus, the user is only charged for actual viewing time of the program, because once the signal is interrupted, the watching and listening ends (see column 5, lines 36-66).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,061,452. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not

patentably distinct from each other because claims 34-42 in the application would have been obvious in view of claims 1-13 of U.S. Patent 6,061,452.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al, U.S. Patent 5,787,171 in view of Hayashi et al., U.S. Patent 4,759,060.

As per claims 34-42, Kubota et al. shows a data transmitter and receiver system for preventing illegal free tapping and utilization of a network (see abstract). Kubota et al. does not teach the use of a charging mechanism based on actual utilization of the encoded data. In addition to the conventional program or monthly subscription fee, Hayashi et al. teaches a fee system based on actual viewing or listening time (see column 4, lines 1-5; column 8, lines 16-21). Hayashi et al. further discloses that a more flexible and reasonable charging system is established to suit the user's interest by charging in units of time actually utilized (see column 8, lines 22-25). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the benefit of an actual watching and listening fee. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the conventional flat fee system (periodic subscription or program fee) to a more flexible actual listening and viewing fee, as per teachings of Hayashi et al.

Furthermore, Kubota et al. discloses an embodiment wherein a timer function is included in the program and a periodical check for the terminal ID can be executed at a fixed time interval (see column 12, lines 18-21). Kubota et al., however, does not teach the use of various requirement checks to the transmitting side every predetermined unit time. Hayashi et al. teaches a continuously executed "check routine" to determine authorized use or whether to terminate use (see figures 5 and 6). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the advantage and benefit of continuously issuing the requirement to the transmitting side until termination. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify any of these variables as part of the continuous requirement check, as per Hayashi et al.

In addition, Kubota et al. discloses an embodiment wherein a timer function is included in the program and a periodical check for the terminal ID can be executed at a fixed time interval (see column 12, lines 18-21). Kubota et al., however, does not teach the use of a recording mechanism to determine actual utilization of data. Hayashi et al. teaches a fee system based on actual viewing or listening time deducted continuously from the user account (see column 4, lines 1-5; column 8, lines 16-21). Hayashi et al. accomplishes this by utilizing a signal from a timer which interrupts the normal control loop to check the balance maintained in the memory unit at periodic intervals, and record the data stored in the memory unit (column 6, lines 38-59). Hayashi et al. is evidence that one of ordinary skill in the art would recognize the benefit of periodically recording use of the encoded data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to periodically record any useful variables such as time and key changes for billing purposes, as per Hayashi et al.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached Tuesday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

bbb
June 3, 2003

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600